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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* PAUL STEPHENS

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Appeal 2009-003132
Application 10/539,849
Technology Center 2600

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Decided: June 9, 2010

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Before JOSEPH F. RUGGIERO, CARLA M. KRIVAK, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 32-55. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

> [Appellant's invention relates to a] method (300) of providing location based services using a wireless communication system (100, 200) that facilitates communication to and/or from a plurality of communication units (250-262). The method includes the step of transmitting a wireless message (220), from a mobile service provider (112) to a number of communication devices in a location (210). The wireless message indicates a service to be provided by the mobile service provider (112) at the location (210). This enables mobile service providers to enhance their business via their mobile communication device, i.e. advertise their services to a geographically near, group of users. Preferably the recipient group of users have previously subscribed to, or registered their interest in, the services provided by the mobile service provider.

(Abstract).

Independent claim 32 illustrative, reading as follows with emphasis added to the disputed claim language:

> 32. A method of providing location based services by a mobile service provider using a wireless communication system that facilitates communication with a plurality of communication units, the method comprising:
>
> providing location information, via a mobile communication unit adapted for use by the mobile service provider *traveling to a previously undisclosed location where a service is to be performed* of at least one of a current location of, and a location to be visited by, the mobile service provider to an intermediate device; and
>
> initiating the transmission of a wireless message, by the intermediate device in dependence on the location information

> provided by the mobile service provider, to a number of communication devices in the at least one of the current location of, and the location to be visited by, the mobile service provider, wherein said wireless message indicates the service to be provided by said mobile service provider at the at least one of the current location of, and the location to be visited by, the mobile service provider.

The Examiner initially rejected all of claims 32-55 as either anticipated by, or obvious over, Haddad, US 2003/0137435 (July 24, 2003) (*see* Non-Final Rejection, mailed Sep. 19, 2006). Haddad discloses a mobile communication system for alerting a user to an expected occurrence of an event that has a start time that can be more accurately predicted as the time of the event approaches (Haddad, Abstract).

In response to the rejections based upon Haddad, Appellant amended the two independent claims, claims 32 and 52, to include the language emphasized above, "traveling to a previously undisclosed location where a service is to be performed" (*see* Amendment filed Feb. 20, 2007). Appellant asserts that the originally-filed Specification's use of the term "roaming" adequately supports the claim amendment regarding the "previously undisclosed location" because a general purpose dictionary defines roaming "as moving about without purpose or plan; (i.e., wander)" (App. Br. 4-6). Appellant also asserts that the claim amendments overcome the rejections over Haddad because Haddad is only directed to predetermined or expected events and occurrences, and further because Kinnunen, US 2001/0018349 (Aug. 30, 2001), fails to account for Haddad's deficiencies (App. Br. 6-8).

The Examiner conversely finds that the claim limitations that were later added by amendment (1) constitute new matter, and (2) still do not distinguish over Haddad. Accordingly:

I. Claims 32-55 stand rejected under 35 U.S.C. § 112 ¶ 1 for failing to comply with the written description requirement. The first issue presented on appeal relates to the written description rejection: Does the originally-filed Specification's recitation of "roaming" provide adequate support for the later-added claim language, "travelling to a previously undisclosed location"?

II. Claims 32-47 and 49-55 stand rejected under 35 U.S.C. § 102(e) as anticipated by Haddad. Claim 48 stands rejected under 35 U.S.C. § 103(a) as obvious over Haddad in view of Kinnunen. The second issue on appeal relates to these art-based rejections: Does Haddad additionally disclose the claimed feature of "the mobile service provider traveling to a previously undisclosed location where a service is to be performed" (*see* App. Br. 6-7 (*citing* claim 32))?

## FINDINGS OF FACT

The record supports the following Findings of Fact by a preponderance of the evidence:

1. As applied to cellular telephone communications, "roaming" means:

- "Use of a cellular phone outside its calling area. Whereas the incoming calls may be free (being charged to the calling party), outgoing calls typically cost more than normal in the roaming mode" (available at http://www.businessdictionary.com/definition/roaming.html);

- "a customer's use of a cellular phone outside the region served by his or her carrier" (available at http://www.yourdictionary.com/roaming).

2. Haddad states (¶ [0047]):

> It will be appreciated that [Haddad's] invention is applicable to other forms of transport beyond buses which have unpredictable arrival and/or departure times. . . It is also possible for a user to be given advance notice of the arrival of non route-fixed transport, such as, a taxi or car: if the position of the vehicle is known and the pick up point known, an advance notice signal can be generated a suitable time before the car arrives.

## ANALYSIS

### I.

The originally-filed Specification's recitation of "roaming" does not provide adequate support for the later-added claim language, "travelling to a previously undisclosed location." As used in the context of cellular telephone communications, "roaming" refers to the use of a cellular phone outside of the user's home service area (Fact 1). We find no evidence that "roaming," in this particular context, further precludes the user from either formulating a travel plan before embarking upon a journey or disclosing the intended travel plans to others. Accordingly, we sustain the Examiner's rejection of claims 32-55 under 35 U.S.C. § 112 ¶ 1.

### II.

We now turn to the question of whether Appellant's amendment overcomes the anticipation and obviousness rejections based upon Haddad. Towards this end, we first note that neither of independent claims 32 and 52 recites any objective baseline for determining relative to what reference time

the claimed location is previously undisclosed. As such, Haddad may be reasonably interpreted as not only disclosing a mobile communication system that alerts a user to the occurrence of an expected event, but also disclosing the claimed feature of "the mobile service provider traveling to a previously undisclosed location where a service is to be performed."

More specifically, Haddad discloses that the invention can be used to "[give] advance notice of the arrival of non route-fixed transport, such as, a taxi. . . if the position of the vehicle is known and the pick up point known" (Fact 2). Implicit in the case of such a taxi-service scenario, the pick-up location is not known by the cab driver (or service provider) until the passenger makes the transport request. As such, the pick-up location may be reasonably interpreted as constituting a "previously undisclosed location." If we were to alternatively find this interpretation to be unreasonably broad, we would raise a significant question of what metes and bounds are, in fact, covered by the claim language, "previously undisclosed location."

For the foregoing reasons, then, Appellant has not persuaded us of error in the Examiner's anticipation rejection of claims 32 and 52. Accordingly, we will sustain the Examiner's decision rejecting those claims and also claims 33-47, 49-51, and 53-55 which depend from claims 32 and 52. Likewise, we will also sustain the Examiner's obviousness rejection of claim 48 over Haddad and Kinnunen. Appellant has not particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness. Rather, Appellant merely reiterates the same arguments with respect to the alleged deficiencies of Haddad in

connection with independent claim 32 (App. Br. 9). We are not persuaded by these arguments, however, for the same reasons discussed above.

## DECISION

The Examiner's decision rejecting claims 32-55 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

## ORDER

AFFIRMED

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